REMARKS

Upon entry of the present amendment, claims 1-3, 5 to 12, and 14 to 25 are pending in the application.

No claims have been amended, claims 4 and 13 have been canceled, and new claims 24 and 25 have been added. No new matter has been introduced by the foregoing amendment.

Applicants are not conceding in this application that the canceled claims would not have been patentable. The present claim amendment is intended only to facilitate expeditious allowance of valuable subject matter. Applicants respectfully reserve the right to present and prosecute the original versions of any canceled claim in one or more continuing applications.

Reconsideration is respectfully requested in view of the foregoing amendment and the following remarks.

Obviousness Rejection over Mayer

Claims 1-3, 6-12, 14-15, and 17-23 have been rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Mayer (US 5,633,037) and the Applicants' admitted state of art for the reasons of record set forth in paragraph 3 of the Office Action mailed on 2/19/2008, because Applicants' previous amendment did not change the scope of the claimed invention. Similarly, claims 4-5, and 13, 15-16 have been rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Mayer (US 5,633,037) for the reasons of record set forth in paragraph 4 of the Office Action mailed on 2/19/2008.

The Office Action quotes a section of Applicants' arguments filed May 19, 2008, in which Applicants stated as follows:

> Mayer, however, does not teach or suggest that the basecoats applied in the refinish are of the same material as the basecoat applied in the original finish, and there is motivation in Mayer to modify Mayer in order to use the same material as the basecoat applied in the original finish.

On page 2, final paragraph, of the present Office Action, the Examiner cites Mayer's column 3, lines 12-23 as teaching that the coating composition may be a pigment-free extract of the aqueous refinish basecoat material. However, it is respectfully submitted that no such teaching is present in the Mayer at the above referenced section. Applicants respectfully submit that Mayer only teaches that the material used in the pigmented basecoat material of the refinish can be the same as the material used in the non-pigmented basecoat material of the refinish. (Mayer, column 14, lines 48-58). However, Mayer does not teach or suggest, or even allude to the basecoat in the refinish having the same material as the basecoat in the original finish, as is recited in independent claim 1.

The foregoing comments are further affirmed in Mayer's exemplary embodiments. In Mayer's examples, the original finish comprised a basecoat based on cellulose acetobutyrate. (Mayer, column 17, lines 16-17). However, Mayer's basecoats 1-5 used in the refinish do not contain any cellulose acetobutyrate. (Mayer, column 21, line 5, to column 22, line 8).

In response, the Office Action states that "Mayer teaches ***any*** known basecoat compositions are suitable in his process (See column 16, lines 36-39)." [emphasis in original]

Applicants respectfully submit that the cited section of Mayer actually states that "other known basecoat compositions, for example those systems described in GB-A-2,073,609 and EP-A-195,931, are also suitable for use in the process according to the invention." This does not amount to a teaching of ***any*** known basecoat composition and, moreover, there is such a thing as a selection invention, even assuming, purely *arguendo*, that any known basecoat composition can be used in a new process. It almost goes without saying that Applicants' selected use of a particular type of basecoat composition goes to the heart of the present invention, that is, the requirement that the key constituents used in the extract of an aqueous basecoat material, in step (1) of claim 1, as well as the aqueous basecoat material of step (2), substantially corresponds or is identical to the aqueous basecoat material (A) or one of the aqueous basecoat materials (A) from which the basecoat (A), in the underlying finish, was produced are the same as in the finish being refinished. It is noted that concentrations and amounts of such constituents can vary and the extract is substantially or entirely free from opaque pigments, as defined in the original specification.

In view of the above, it seems *in apropos* for the Office Action to contend that a claim limitation that goes to the heart of the novelty and inventiveness in the present invention is rendered obvious by *any* basecoat composition.

As stated in the original specification, on page 2, paragraph [0006], the known refinish process, such as taught by Mayer, is unable to solve the problems which occur when multicoat color and/or effect paint systems are overcoated on the line at the automaker's plant, since such overcoating requires quite different amounts of coating materials and an entirely different logistical system than for refinish in the conventional sense, which of course is carried out above all in vehicle finishing workshops.

The fact that Mayer does not limit his teaching to a particular basecoat material for original finish and finish for refinish [Emphasis in original], as alleged in the Office Action, does not address the fact that Applicants, in contrast, *does* limit the claims to a particular refinish, that is, one limited with respect to the original finish being refinished.

It is respectfully submitted that the Examiner's analysis overlooks the fact, as stated before than there are not two choices, but as the Examiner implied before, many choices based on any basecoat, of which many more than two exist. The Office Action might as well contend that there are only "two obvious combinations," the invention or some other alternative to the invention.

Furthermore, the present claim 1 is not limited to "two obvious combinations: either the same or different known basecoat compositions," as alleged in the Office Action but, as noted above, the present invention does not necessary use the "same" basecoat composition, which is a significant advantage of the present invention. As stated in the present specification, on page 1, paragraphs [003] and [0004]:

> The basic assumption in the art is that a shade and/or optical effect produced by ESTA application cannot be copied pneumatically. In order to prevent at least partly the shift in shade and change in optical effect, OEM finishes are refinished on the line at the automaker's plant using conventional basecoat materials, i.e., based on materials comprising organic solvents, whose shade and/or optical effect are adapted to those of the basecoats to be refinished. However, this approach is

> very complicated, since a conventional basecoat material has to be prepared and stocked at the automaker's plant separately for every production shade and/or effect. [Emphasis added]

In contrast, the present process only requires, with respect to the extract of step (1) and the aqueous basecoat material of step (2) that key constituents such as binders and crosslinkers substantially correspond or be identical with respect to the underlying paint system, but can vary in terms of amounts, concentrations, and additives, as described in the application. Thus, in light of the prior art, it was surprising and unforeseeable for the skilled worker that the object on which the present invention was based could be achieved by means of the process of the invention. A particular surprise was that the multicoat color and/or effect paint systems with which the finishes (for example, an OEM finish) were overcoated no longer exhibited any deleterious shift in shade and/or any deleterious change in optical effect, especially metallic effect, even when the finish had been produced by means of electrostatic spray application. This meant that, contrary to the opinion of the art, it was indeed surprisingly possible to copy pneumatically the shades and optical effects produced by means of ESTA application. A particular surprise was that the multicoat paint systems produced by the process of the invention exhibited outstanding adhesion to OEM finishes. It should be noted that this is particularly the case, as required by claims 23 and 24, where the refinish occurs on-line at an automaker's plant and where, as stated before, the overcoating requires quite different amounts of coating materials and an entirely different logistical system than for refinish in the conventional sense as carried out above all in vehicle finishing workshops.

Importantly, the Office Action ignores the fact that the claimed process is not merely a matter of applying a basecoat but also includes applying an extract of an aqueous basecoat material, substantially free or entirely free from opaque pigments. Again, the choice for the skilled artisan is any extract. There is no teaching that it should relate to the aqueous basecoat material (A) as specified in claim 1.

Moreover, new claim 24 requires that the extract is a coating material which comprises the same binder or binders and the same crosslinking agent or agents as the aqueous basecoat material (A), except at lower concentrations than are employed in the

basecoat material (A). Hence, the binary choice constructed in the Office Action, even superficially, completely breaks down at this point. One might as well argue that every invention is a series of binary decisions just as the universe is a giant digital computer.

Furthermore, new claim 24 requires, as do claims 9 and 11, that the aqueous basecoat material (A) and its extract or an extract substantially corresponding to it comprise at least one ionically and/or nonionically stabilized polyurethane binder which is saturated, unsaturated, and/or grafted with olefinically unsaturated compounds and, furthermore, that the aqueous basecoat material (A) and its extract or an extract substantially corresponding to it further comprise at least one crosslinking agent selected from the group consisting of amino resins, blocked polyisocyanates, and tris(alkoxycarbonylamino)triazines. Although one might contend that this limitation can be reduced to one of two obvious combinations, a particular polyurethane binder and crosslinking agent, or any other ones, Applicants believe that this is not relevant to the invention as a whole.

The Office Action states that Mayer's examples of a basecoat in the original finish based on cellulose acetobutyrate, as compared to a refinish that does not contain any cellulose acetobutyrate, does not teach away from a broader disclosure. 07/15/2008 Office Action on page 3, second to last paragraph. Applicants submit, however, that even assuming *arguendo* that it does not teach away from the invention, it certainly doesn't teach the invention.

The Office Action also states that "Applicants admitted in P4 that 'In order to prevent at least partly the shift in shade and change in optical effect, OEM finishes are refinished on the line at the automaker's plant using conventional basecoat materials, i.e., based on materials comprising organic solvents, whose shade and/or optical effect are adapted to those of the basecoats to be refinished....' 07/15/2008 Office Action on page 34, last paragraph. The Office Action further states that "Obviously, in on-line OEM refinishing, the same basecoat material should be used for original and refinish compositions since the refinish basecoat material should be adapted to those of the basecoats to be refinished."

Applicants respectfully submit that the Examiner is interpreting Applicants' quoted statement in the specification with hindsight. The quoted statement simply does not state that the same basecoat material should be used for original and refinish compositions. The quoted statement states that the shade and/or optical effect of the refinish compositions are adapted to those of the basecoats to be refinished. Similarly, in the Office Action of 02/19/2008, the Office Action stated that Applicants admitted that Mayer disclosed all the limitations of the claims invention, on page 1 of the specification, except that the known refinish process was unable to solve existing problems relating to refinish in the conventional sense, which of course is carried out in finishing shops compared to overcoating on the line at the automaker's plant. 02/19/2008 Office Action page 4, second paragraph. This so-called admission is not an admission of anything that is not disclosed in Mayer, so the Examiner's use of this so-called admission appears to have no added content. Applicants respectfully request clarification as to what the Examiner is contending that Applicants have admitted, other than what is disclosed in Mayer already, with respect to any limitations of the presently claimed invention.

Furthermore, Mayer fails to teach, as required by claim 25, that the pneumatic spray application in step (3) is conducted at a spraying pressure of from 0.3 to 1.8 bar, and the pneumatic spray application in step (1) is conducted with a spraying pressure of from 2.5 to 5 bar. To the contrary, Mayer employs a spray pressure of 2-3 bar in a first step, as specified in col. 22, line 31.

With respect to claims 23 and 24, the Office Action of 02/19/2008, which was repeated in the present Office Action, states that Mayer involves repairing a multicoat original finish, such as is customary in automotive production line painting, as the substrate. [emphasis added] Applicants submit, however, that the source of the substrate being finished is an entirely different matter than the claim requirement that the process is carried out on a line at an automaker's plant. Of course, refinishing can obviously and even normally be performed on damaged areas of a finish from automotive production line painting. Nowhere in column 16, lines 40-67, of Mayer is the requirement of claim 23 and 24 disclosed or taught.

New claims

New claim 24 contains the limitations of claim 1 and, in addition, the limitations of dependent claims 3, 9, 11, 21, and 23. In addition, claim 24 states that "the extract is a coating material which comprises the same binder or binders and the same crosslinking agent or agents as the aqueous basecoat material (A), except at lower concentrations than are employed in the basecoat material (A)," which is supported on page 8, paragraph [0032], of the original specification.

New claim 25 relating to spray pressures is supported by original claims 4 and 13, and also page 9, paragraph [0038], of the original specification.

Conclusion

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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